

**APPENDIX IV**

Serial No.: 09/577,551

Docket No.: 53481US009

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Final Office Action mailed from the U.S. Patent and Trademark Office on May 24, 2002.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/577,551	05/24/2000	Wayne K. Dunshee	53481USA+ <sup>B</sup>	5353

7590 05/24/2002

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US009

EXAMINER

NILAND, PATRICK DENNIS

ART UNIT PAPER NUMBER

1714

DATE MAILED 05/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/577,551

Applicant(s)

DUNSHEE ET AL.

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-13, 16-45 and 49-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-13, 16-45 and 49-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. The amendment of 3/4/02 has been entered. Claims 11-13, 16-45, and 49-52 are pending.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 11, 13, 16-21, 23, 24, 25-27, 30-33, and 39-43 are rejected under 35

U.S.C. 102(b) as being anticipated by US Pat. No. 5162141 Davey et al..

Davey et al. discloses a method falling within the scope of the instant claims 11, 13, 15-21, 23, 24, 25-27, 30-33, and 39-43 at the abstract; column 3, lines 19-42 and 58-65, many of these polymers contain elastomeric properties necessarily: column 4, lines 1-68; column 5, lines 1-31; column 6, lines 50-68, in which the polyurethane primer layer of Permuthane UE-40-570 is expected to necessarily possess a molecular weight within the broad range of the instant claims in order to function properly based on viscosity (definition of viscosity average molecular weight) and physical property (polymer texts relate physical properties to molecular weight) considerations. Since the image of the instant claims is not specified, the polyurethane printed

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onto the elastomer of the patentee falls within the scope of the instantly claimed "image". The instant claims recite "comprising" and therefore encompass other layers of printing. This rejection is maintained.

5. Claims 11-13, 16-45 and 49-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5162141 Davey et al. in view of US Pat. No. 4334530 Hassell and EP 596503 Miyamoto et al..

Davey et al. discloses a method falling within the scope of the instant claims 11, 13, 16-21, 23, 24, 25-27, 30-33, and 39-43 at the abstract; column 3, lines 19-42 and 58-65, many of these polymers contain elastomeric properties necessarily: column 4, lines 1-68; column 5, lines 1-31; column 6, lines 50-68, in which the polyurethane primer layer of Permuthane UE-40-570 is expected to necessarily possess a molecular weight within the broad range of the instant claims in order to function properly based on viscosity (definition of viscosity average molecular weight) and physical property (polymer texts relate physical properties to molecular weight) considerations. Since the image of the instant claims is not specified, the polyurethane printed onto the elastomer of the patentee falls within the scope of the instantly claimed "image". The instant claims recite "comprising" and therefore encompass other layers of printing. Davey is not limited to flooring nor rigid substrates as argued by the applicant. Davey clearly specifies polymeric sheet generically, including sheets of polymers which are necessarily elastomeric. This clearly translates to coating bandages, as stated below. Besides, if it works on flooring, it would have been expected to work exceptionally on a bandage since the bandage does not get nearly the

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stresses and strains as flooring. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to coat a bandage with an image according to the instant claims because it is known to coat bandages with images as shown by Hassell, the color of the image is only a matter of preference, and the use of the instantly claimed primers and overcoats would have been expected to give the results stated by Davey et al. and Miyamoto et al.. It is noted that primer and overcoat would have been expected to contribute to abrasion resistance because primer adheres the layer more firmly by definition making it harder to scrape off and overcoat gives another layer that must be scraped off, each necessarily requiring more energy to scrape off resulting in abrasion resistance over the ink image not containing these layers.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Niland whose telephone number is (703) 308-3510. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

pn

May 18, 2002



Patrick Niland  
Primary Examiner  
Art Unit 1714